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DIGEO, INC C/O STOEL RIVES LLP			VAN HANDEL, MICHAEL P	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/941,239	SEARS, MICHAEL E.	
	Examiner	Art Unit	
	Michael Van Handel	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 October 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2,5-19,21,22,25-39,41,42,45-59 and 61-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1, 2, 5-19, 21, 22, 25-39, 41, 42, 45-59, 61-70 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/24/2007 has been entered.

Response to Amendment

1. This action is responsive to an Amendment filed 10/24/2007. Claims **1, 2, 5-19, 21, 22, 25-39, 41, 42, 45-59, 61-70** are pending. Claims **1, 5, 6, 21, 25, 26, 41, 45, 46, 61-64, 69, and 70** are amended. Claims **3, 4, 20, 23, 24, 40, 43, 44, 60** are canceled. The examiner hereby withdraws the objections to claims **5-7, 25-27, 45-47, 69, 70** in light of the amendment. The examiner hereby further withdraws the objection to the specification in light of the amendment. The examiner hereby still further withdraws the rejection of claims **20, 40, 60** under 35 USC 112, first paragraph, in light of the amendment.

Response to Arguments

1. Applicant's arguments regarding claims **1, 21, 41, and 61-64**, filed 10/24/2007, have been fully considered, but they are not persuasive.

Regarding claims **1, 21, 41, and 61-64**, the applicant argues that Bruno et al. contains no disclosure whatsoever regarding storing a video signal in response to a determination being made that a connected device is not capable of receiving video signals. The examiner respectfully disagrees. As noted in the Office Action mailed 9/20/2007, Bruno et al. discloses a method and apparatus for recording and indexing video, audio and data information exchanged during a multimedia conference. A workstation and/or participant-identifying signal generated by a multipoint control unit is stored, together or in correspondence with the audio and video information, for subsequent ready retrieval of the stored multimedia information (see Abstract & col. 5, l. 33-40). Bruno et al. further discloses that the MCU is capable of accommodating an additional conferee participating via a conventional, voice-only telephone 34 connected to the MCU 26 through audio add-on line 36. Although the telephone participant will have no video interaction with the other participants of the conference, once the telephone participant is identified to the MCU a still image or photograph of that added participant may be retrieved from a database and displayed on the other participants' screens 14 when the telephone participant is speaking (col. 9, l. 23-33). The examiner interprets identifying a telephone participant as "determining that the second device is not capable of displaying video signals," as currently claimed. Since the video is continually recorded after the telephone participant is identified, the examiner interprets this as "in response to determining that the second device is not capable of displaying the captured video signals, caching the captured video signals for subsequent display after the two-way audio communication is concluded," as currently claimed.

Further regarding claims **1, 21, 41, and 61-64**, the applicant argues that Bruno et al. teaches precisely the opposite of a system that does not cache unless a determination is made that

a non-video-enabled device is present, because the system caches video signals regardless of whether any of the participants have non-video-enabled communication devices. The examiner respectfully disagrees. Bruno et al. discloses that the each user in the multimedia conference call must identify himself or herself to the MCU as the conference call is initiated (col. 6, l. 5-6, 50-54). In the audio embodiment as well, Bruno et al. discloses that each conference participant must expressly identify her or himself to the computer at the commencement of the conference, so that the identity of each speaker or participant can be determined (col. 7, l. 39-46). In the embodiment with the audio add-on line, the telephone participant again must identify himself or herself to the MCU, so that a still image or photograph of the participant may be retrieved from a database and displayed on the other participants' screens when the telephone participant is speaking (col. 9, l. 25-33). This participant identification is necessary to perform voice activated switching in the conference call (col. 6, l. 1-6) and to create indexes in the archive file of the conference corresponding to the speaker identities or workstations involved with a particular part of the file (col. 6, l. 24-31). Since the voice-only telephone must be identified when initiating a call between the voice-only telephone and any of the multimedia workstations, the examiner interprets this as "wherein the captured video signals are not cached unless a determination is made that the second device is not capable of displaying the captured video signals," as currently claimed.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims **1, 2, 5-19, 21, 22, 25-39, 41, 42, 45-59, 61-70** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Referring to claims **1, 21, 41, and 61-64**, the examiner fails to find support for the amended phrase “wherein the captured video signals are not cached unless a determination is made that the second device is not capable of displaying the captured video signals” of claim 1 and the similarly amended language of claims 21, 41, and 61-64. Applicant argues that this is an inherent limitation of the previous claim language “in response to determining that the second device is not capable of displaying the captured video signals, caching the captured video signals for subsequent display after the two-way audio communication is concluded;” however, the examiner respectfully disagrees. The fact that a particular second event happens in response to a first event does not mean that the first event is necessary for the second event to happen. The examiner also fails to find support for the amended phrases in the specification. “Any negative limitation or exclusionary proviso must have basis in the original disclosure ... The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement” (See MPEP 2173.05(i)).

Claims **2, 5-19, 22, 25-39, 42, 45-59, and 65-70** are rejected as being dependent on the above-listed independent claims.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims **1, 2, 6-12, 14-19, 21, 22, 26-32, 34-39, 41, 42, 46-52, 54-59, 63** are rejected under 35 U.S.C. 102(b) as being anticipated by Bruno et al.

Referring to claims **1, 21, 41, and 63**, Bruno et al. discloses a method/system/computer-readable medium for enabling communication between video-enabled and non-video-enabled communication devices, the method/system/computer-readable medium comprising:

- detecting a request to establish video communication between a first device and a second device (col. 5, l. 41-54; col. 6, l. 5-6; col. 8, l. 25-30; & Fig. 1);
- determining that the second device is not capable of displaying a video signal (col. 9, l. 23-33);
- establishing two-way audio communication between the first and second devices (col. 9, l. 23-29);
- capturing video signals generated by the first device during the two-way audio communication (col. 5, l. 33-40; col. 6, l. 1-12, 24-46; & col. 9, l. 12-23);

- in response to determining that the second device is not capable of displaying the captured video signals, caching the captured video signals for subsequent display after the two-way audio communication is concluded (the examiner notes that the video signals of Bruno et al. are always stored for subsequent retrieval. The examiner interprets this as “caching the captured video signals for subsequent display” as currently claimed)(col. 5, l. 33-37), wherein the captured video signals are not cached unless a determination is made that the second device is not capable of displaying the captured video signals (col. 4, l. 55-59; col. 5, l. 28-32; col. 6, l. 5-6, 50-54; col. 7, l. 39-46; & col. 8, l. 27-33).

Bruno et al. does not disclose that the captured video signals are not cached unless a determination is made that the second device is not capable of displaying the captured video signals.

Referring to claims **2, 22, and 42**, Bruno et al. discloses the method/system/computer-readable medium of claims 1, 21, and 41, respectively, further comprising capturing audio signals generated by the first and second devices during the two-way audio communication and caching the captured audio signals (col. 5, l. 33-40; col. 6, l. 1-12, 24-46; & col. 9, l. 12-23, 40-60).

Referring to claims **6, 7, 26, 27, 46, and 47**, Bruno et al. discloses the method/system/computer-readable medium of claims 66, 68, and 70, wherein caching comprises transmitting the locator link to a user of the non-video-enabled device and the locator link is transmitted to the user via a messaging system (the examiner notes that pre-recorded conference

information can be retrieved from a menu of options sent to the user via a voice response unit (VRU)(col. 9, l. 34-49).

Referring to claims **8, 28, and 48**, Bruno et al. discloses the method/system/computer-readable medium of claims 65, 67, and 69, respectively, wherein the terminal comprises a display screen, the method further comprising displaying the video signals on the display screen of the terminal (col. 9, l. 55-57).

Referring to claims **9, 29, and 49**, Bruno et al. discloses the method/system/computer-readable medium of claims 2, 22, and 42, respectively, further comprising: receiving a request from a terminal to transmit the cached video and audio signals; retrieving the cached video and audio signals from a storage device; and transmitting the video and audio signals to the terminal (col. 5, l. 33-40; col. 6, l. 24-31; & col. 9, l. 18-23, 55-60).

Referring to claims **10, 30, and 50**, Bruno et al. discloses the method/system/computer-readable medium of claims 9, 29, and 49, respectively, wherein the terminal comprises a display screen and a speaker (col. 5, l. 12-19), the method/system/computer-readable medium further comprising:

- displaying the video signals on the display screen of the terminal (col. 9, l. 55-57);
- and
- synchronously outputting the audio signals on the speaker of the terminal (col. 9, l. 18-23).

Referring to claims **11, 31, and 51**, Bruno et al. discloses the method/system/computer-readable medium of claims 1, 21, and 41, respectively, wherein caching comprises encoding the

video signals in a compressed format; and storing the encoded video signals in a storage device (col. 8, l. 20-67 & col. 9, l. 1-11).

Referring to claims **12, 32, and 52**, Bruno et al. discloses the method/system/computer-readable medium of claims 11, 31, and 51, respectively, wherein the compressed format comprises a form of predictive coding (the examiner notes that in content-based sampling, the number of samples to be taken is dependent on the current amount and frequency of movement at the workstation)(col. 8, l. 61-67 & col. 9, l. 1-2).

Referring to claims **14, 34, and 54**, Bruno et al. discloses the method/system/computer-readable medium of claims 1, 21, and 41, respectively, wherein the first device comprises a camera for capturing video signals (col. 5, l. 17-18).

Referring to claims **15, 35, and 55**, Bruno et al. discloses the method/system/computer-readable medium of claims 1, 21, and 41, respectively, wherein the first device is selected from the group consisting of a video-enabled telephone, a video-enabled cellular telephone, a video-enabled personal computer (col. 5, l. 12-18), a video-enabled interactive television (ITV) system, and a video-enabled personal digital assistant (PDA).

NOTE: The USPTO considers the applicant's "selected from the group consisting of" language to be anticipated by any reference containing any of the subsequent corresponding elements.

Referring to claims **16, 36, and 56**, Bruno et al. discloses the method/system/computer-readable medium of claims 1, 21, and 41, respectively, wherein the second device is selected from the group consisting of a non-video-enabled telephone (col. 9, l. 23-33), a non-video-enabled cellular telephone, a non-video-enabled personal computer, a non-video-enabled interactive television (ITV) system, and a non-video-enabled personal digital assistant (PDA).

NOTE: The USPTO considers the applicant's "selected from the group consisting of" language to be anticipated by any reference containing any of the subsequent corresponding elements.

Referring to claims **17, 37, and 57**, Bruno et al. discloses the method/system/computer-readable medium of claims 1, 21, and 41, respectively, wherein the video signals are cached by a server (control unit 30, multipoint control unit (MCU) 26, and digital computer 32) coupled to the first and second devices by at least one network (col. 5, l. 33-40 & Fig. 1).

Referring to claims **18, 38, and 58**, Bruno et al. discloses the method/system/computer-readable medium of claims 17, 37, and 57, respectively, wherein the at least one network comprises at least one of a cable television network, a direct satellite broadcast (DBS) network, a wide-area network (WAN), a local-area network (LAN), a telephone network (col. 9, l. 23-27), and the Internet.

NOTE: The USPTO considers the applicant's "at least one of" language to be anticipated by any reference containing any of the subsequent corresponding elements.

Referring to claims **19, 39, and 59**, Bruno et al. discloses the method/system/computer-readable medium of claims 17, 37, and 57, respectively, wherein the server is located within a broadcast center associated with the at least one network (the examiner notes that the MCU displays the video of the loudest speaking user/conferee on each of the other users' workstations. Since all of the other users receive the same video, the examiner interprets the MCU, digital computer, and control unit to be a broadcast center associated with the network)(col. 4, l. 67).

Referring to claims **65-70**, Bruno et al. discloses the method/system/computer-readable storage medium of claims 1, 21, and 41, respectively, further comprising:

- receiving a request, comprising a locator link indicating a stored location of the cached video signals) from a terminal to transmit the cached video signals (the examiner notes that an accessor retrieves a recorded video segment from a previously recorded conference by way of a variety of categories. The examiner further notes that in retrieving a particular video segment, the accessor is inherently indicating a stored location of the video segment)(col. 6, l. 9-12, 24-31, 39-46 & col. 9, l. 12-23, 40-60);
- retrieving the cached video signals from a storage device (col. 9, l. 12-23, 40-60); and
- transmitting the video signals to the terminal (col. 9, l. 40-60).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
2. Claims 5, 25, 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bruno et al. in view of Milewski et al.

Referring to claims 5, 25, and 45, Bruno et al. discloses the method/system/computer-readable medium of claims 66, 68, and 70, respectively. Bruno et al. further discloses recording and indexing the participants of and data exchanged or transmitted during a multimedia conference, such as a videoconference (col. 3, l. 19-24, 35-40; col. 5, l. 33-40; & col. 6, l. 1-12, 24-31). Bruno et al. does not disclose that the locator link comprises a Universal Resource

Locator (URL). Milewski et al. discloses generating URLs for each segment of an archived video. The viewer uses the URL to access the archived video at particular point of interest in the future (col. 2, l. 1-19). The user requests a URL for future access of the video with a telephone or PDA (col. 6, l. 50-63 & col. 7, l. 1-6). A server then sends the URL of the archived program to the user's PC (for example, by electronic mail (e-mail)), so that the archived video can be retrieved by the user in the future)(col. 4, l. 56-61 & 12-22). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the archived videoconference retrieval system of Bruno et al. to include using a URL to retrieve the video signals, such as that taught by Milewski et al. in order to allow bookmarking archived items of interest for future reference purposes (Milewski et al. col. 1, l. 50-52).

3. Claims 13, 33, 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bruno et al.

Referring to claims 13, 33, and 53, Bruno et al. discloses the method/system/computer-readable medium of claims 11, 31, and 51, respectively. Bruno et al. further discloses sampling and compressing video signals using content-based sampling methods and storing the video signals in a memory (col. 8, l. 65-67 & col. 9, l. 18-23). Bruno et al. does not disclose that the storage device is selected from the group consisting of a magnetic storage device, an optical storage device, and a random access memory (RAM). Applicant's failure to adequately traverse the Examiner's taking of Official Notice (that it is notoriously well known in the prior art to store compressed video in a magnetic storage device) in the last Office Action is taken as an admission of the fact(s) noticed. It would have been obvious to one of ordinary skill in the art at the time

that the invention was made to modify the storage of Bruno et al. to include storing the compressed video on a magnetic storage device, such as that taught by the admitted prior art in order to provide more memory storage space at a low cost.

NOTE: The USPTO considers the applicant's "selected from the group consisting of" language to be anticipated by any reference containing any of the subsequent corresponding elements.

4. Claims **61, 62, 64** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bruno et al. in view of Schultheiss.

Referring to claims **61, 62, and 64**, Bruno et al. discloses a method/system for enabling communication between an audio/video conferencing workstation terminal and non-video-enabled communication device, the method comprising:

- detecting a request to establish video communication between the audio/video conferencing workstation and the non-video-enabled communication device (col. 5, l. 41-54; col. 6, l. 5-6; col. 8, l. 30-25; & Fig. 1);
- determining that the non-video-enabled communication device is not capable of displaying a video signal (col. 9, l. 23-33);
- establishing two-way audio communication between the audio/video conferencing workstation and the non-video-enabled communication device (col. 9, l. 23-29);
- capturing video and audio signals generated by the audio/video conferencing workstation during the two-way audio communication (col. 5, l. 33-40; col. 6, l. 1-12, 24-46; & col. 9, l. 12-23);

- in response to determining that the non-video-enabled communication device is not capable of displaying the captured video signals, caching the captured video and audio signals within a storage device for subsequent display and playback after the two-way audio communication is concluded (the examiner notes that the video signals of Bruno et al. are always stored for subsequent retrieval. The examiner interprets this as "caching the captured video signals for subsequent display" as currently claimed)(col. 5, l. 33-37), wherein the captured video signals are not cached unless a determination is made that the non-video-enabled communication device is not capable of displaying video signals (col. 4, l. 55-59; col. 5, l. 28-32; col. 6, l. 5-6, 50-54; col. 7, l. 39-46; & col. 8, l. 27-33);
- receiving a request from a terminal to transmit the cached video and audio signals, (the examiner notes that an accessor retrieves a recorded video segment from a previously recorded conference by way of a variety of categories (col. 6, l. 9-12, 24-31, 39-46 & col. 9, l. 12-23, 40-60);
- retrieving the cached video and audio signals from the storage device (col. 9, l. 12-23, 40-60); and
- transmitting the video and audio signals to the terminal for display and playback thereon (col. 9, l. 40-60).

Bruno et al. does not disclose that the audio/video conferencing workstation terminal be an interactive television system. Schultheiss discloses a personal computer that is used to relay audio and video telephone communications between external telephone networks and a television (col. 1, l. 43-50 & col. 2, l. 12-15). A television interface unit includes a video camera

and a microphone, which are used to produce a video telephone signal (col. 2, l. 48-50).

Schultheiss further discloses allows a user to participate in audio or video conferences (col. 4, l. 36-38; col. 7, l. 64-67; & col. 8, l. 1-4). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the audio/video conferencing workstation terminal of Bruno et al. to be a television video telephone system, such as that taught by Schultheiss in order to allow participation in a video conference from a device at which individual and family gatherings often occur (Schultheiss col. 1, l. 55-59 & col. 7, l. 64-67).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Van Handel whose telephone number is 571-272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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